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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/927,259 | 08/13/2001 | Kaoru Watanabe | Q65822 | 4313 |

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

SAGER, MARK ALAN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3714

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,259

Applicant(s)

WATANABE ET AL. *CA*

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 8 and 9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. Newly submitted claim 8-9 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claim 1-7, drawn to display device, classified in class 463, subclass 9 or 16.
- II. Claim 8-9, drawn to a device, classified in class 463, subclass 36 or 46.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I (display device) has separate utility such as display device to display a selectable theme, as claimed therein; while invention II (device) has separate utility such as a device to input game parameters. See MPEP § 806.05(d).

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (invention II) as claimed does not require the particulars of the subcombination (invention I) as claimed because the device does not require a selectable theme as required by invention I claims; further, the subcombination (invention I) does not require the particulars of the combination (invention II) because the display device does not require setting of a number of pay lines or the selection of wager amount as required by invention II claims. The subcombination has separate utility such as display device; while, the combination has a separate utility as a device.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Alternatively, because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 8-9 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

3. Claim 1-2, is rejected under 35 U.S.C. 102(e) as being anticipated by Brossard (6302790). Brossard discloses a audio visual output for a gaming device teaching claimed features, as broadly claimed, including a selectable theme (2:15-42, 3:13-5, 4:8-19, 5:9-20, 11:32-38) having a user display content selector (supra) in a game machine that provides a bonus (5:53-61, 6:16-58), whereby the display device comprises an indicator (figs. 1-4C), a recording medium (512), a display content selector (4:8-19, fig. 1-8), a display control device (2:15-42,

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3:13-5, 4:8-19, 5:9-.20, 6:16-58, 11:32-38) which a player can actuate the display content selector (sic).

Claim Rejections - 35 USC § 103

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brossard ('790) in view of Walker ('041). Brossard discloses a display device comprising claimed features (supra) except a 'user operation prevention device for preventing actuation by a user of the gaming machine.' It is noted that a user, as best understood, of instant invention appears to be an operator or player (3:15-16), and instant claim has been examined where user is player or operator. Walker discloses a game device that teaches a user operation prevention device for preventing actuation by a user of the gaming machine via an eligibility lockout (5:25-26, 37-41) so as to permit selective player participation. Therefore, it would have been obvious to an artisan at a time prior to the invention to add user operation prevention device for preventing actuation by a user of the gaming machine as taught by Walker to Brossard's gaming device to permit selective player participation.

5. Claim 4-6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brossard in view of Okada (4508345). Brossard discloses a display device comprising claimed features (supra) a variable display stop device that stops variable display of the variable display device (clm 4) wherein the variable display stop device is actuated by a player (clm 5). Applicant's background admission of prior art (1:18-3:5) is evidence of a slot machine being of a game with a variable display stop device which stops variable display of the variable display device wherein the variable display stop device is actuated by a player to provide a skill stop actuator for players' selective input to use skill to stop spin (virtual or reel) of variable display. Further, Okada

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discloses a slot machine with a bonus feature having a skill stop teaching variable display stop device which stops variable display of the variable display device wherein the variable display stop device is actuated by a player so as to provide a skill stop actuator for players' selective input to use skill to stop spin of variable display. Therefore, it would have been obvious to an artisan at a time prior to the invention to add a variable display stop device which stops variable display of the variable display device wherein the variable display stop device is actuated by a player as admitted prior art by Applicant or as taught by Okada to Brossard's game device so as to permit a skill stop actuator for players' selective input to use skill to stop spin (virtual or reel) of variable display.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brossard in view of Okada as applied to claim 4 above, and further in view of Walker ('041). Brossard in view of Okada discloses/suggests a game machine including claimed features (supra) except a 'user operation prevention device for preventing actuation by a user of the gaming machine.' Walker discloses a game device that teaches a user operation prevention device for preventing actuation by a user of the gaming machine via an eligibility lockout (5:25-26, 37-41) so as to permit selective player participation. Therefore, it would have been obvious to an artisan at a time prior to the invention to add user operation prevention device for preventing actuation by a user of the gaming machine as taught by Walker to Brossard's gaming device in view of Okada to permit selective player participation.

Response to Arguments

7. Applicant's arguments with respect to claim 1-7 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

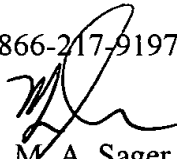
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 703-308-0785. The examiner can normally be reached on T-F, 0700-1700 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. A. Sager
Primary Examiner
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MAS